

Ref.: T.Heering

TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED OFFICE (DO/US)

<u>PCT/DE99/03771</u>	<u>29 November 1999</u>	<u>27 November 1998</u>
International Application Number	International Filing Date	Priority Date(s) Claimed

**METHOD FOR BILLING SERVICES WHICH CAN BE  
RETRIEVED FROM THE INTERNET**

Title of Invention

HEERING, Thomas

Applicant(s) for DO/US

<p>"Express Mail" Label No. <u>EK907967858US</u></p> <p>Date of Deposit <u>MAY 22, 2001.</u></p> <p>I hereby certify that this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.</p> <p><u>Michael Bemas</u> (Type or print name of person mailing paper or fee)</p> <p><u>Michael Bemas</u> (Signature of person mailing paper or fee)</p>
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BOX PCT  
Assistant Commissioner for Patents  
Washington, D.C. 20231

To the United States Designated Office (DO/US):

- I. Accompanying this transmittal letter are certain items which are required under 35 U.S.C. 371 in order that United States National processing of the above identified International application may commence:
- ( ) at the expiration of the applicable time limit under PCT Articles 22 and 39(1) according to the provisions of 35 U.S.C. 371(b).
  - (X) as soon as possible upon receipt of this express request under 35 U.S.C. 371(f).

## 1. The U.S. National fee [35 U.S.C. 371(c)(1)]

a. ( ) was previously transmitted by applicant on (date)\_\_\_\_\_.

b. (X) is submitted herewith as follows:

FOR	NO. FILED	NO. EXTRA	SMALL ENTITY			OTHER THAN	
			RATE	FEE	or	RATE	FEE
Basic Fee	(Search report has been prepared by the EPO)	////		\$430	or	////	\$860
Total Claims	-20 =	--	x 9 =		or	x18 =	\$
Ind. Claims	1-3	--	x 40 =		or	x80 =	\$
(X) Multiple Dependent Claim Presented			+135 =	135	or	+270 =	\$
TOTAL NATIONAL FEE				\$ 565	or		\$

i. ( ) Enclosed is a check for \_\_\_\_\_ to cover the:

ii. (X) Please charge the filing fee, multiple dependent claim fee (if applicable), excess independent claims fee (if applicable), and excess total claims fee (if applicable) to Deposit Account No. 23-1703.

iii. (X) The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 23-1703. A duplicate copy of this sheet is enclosed.

## 2. A copy of the International application as filed [35 U.S.C. 371(c)(2)]:

a. (X) is transmitted herewith.

b. ( ) is not required as the application was filed with the United States Receiving Office.

c. ( ) has been transmitted

- i. ☐ by the International Bureau. Date of mailing of the application (from form PCT/IB/308): \_\_\_\_\_ A copy of form PCT/IB/308 is enclosed.
- ii. ☐ by applicant on (date) \_\_\_\_\_.
3. A translation of the International application into the English language [35 U.S.C. 371(c)(2)]:
- a. ☒ is transmitted herewith.
- b. ☐ is not required as the application was filed in English.
- c. ☐ was previously transmitted by applicant on (date) \_\_\_\_\_.
4. Amendments to the claims of the International application under PCT Article 19 [35 U.S.C. 371(c)(3)]:
- a. ☐ are transmitted herewith.
- b. ☒ have been transmitted and the amendments are attached to the International Preliminary Examination Report - PCT/IPEA/409. A copy of the German language International Preliminary Examination Report is attached.
- i. ☐ by the International Bureau. Date of mailing of the amendments (from form PCT/IB/308): \_\_\_\_\_.
- ii. ☐ by applicant on (date) \_\_\_\_\_.
- c. ☐ have not been transmitted as
- i. ☐ no notification has been received that the International Searching Authority has received the Search Copy.
- ii. ☐ the Search Copy was received by the International Searching Authority but the Search Report has not yet issued. Date of receipt of Search Copy (from form PCT/ISA/202): \_\_\_\_\_.
- iii. ☐ applicant chose not to make amendments under PCT Article 19. Date of mailing of Search Report (from form PCT/ISA/210): \_\_\_\_\_.

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- iv. ( ) the time limit for the submission of amendments has not yet expired. The amendments or a statement that amendments have not been made will be transmitted before the expiration of the time limit under PCT Rule 46.1.
5. A Translation of the amendments to the claims under PCT Article 19 [35 U.S.C. 371(c)(3)]:
- ☒ will be transmitted to the USPTO.
  - ☐ is not required as the amendments were made in the English language.
  - ☐ has not been transmitted for reasons indicated at point I.4.b. or c. above.
6. An executed declaration for patent application of the inventors [35 U.S.C. 371(c)(4)] complying with 35 U.S.C. 115:
- ☐ was previously submitted by applicant on (date)  
\_\_\_\_\_
  - ☐ is submitted herewith;  
and such oath or declaration
    - ☐ are attached to the application.
    - ☐ identify the application and any amendments under PCT Article 19 which were transmitted as stated in points 1.2.b. or c. and 1.4. and states that they were reviewed by the inventor as required by 37 CFR 1.70.
  - ☒ will be submitted subsequently.

## II. Concerning other documents:

- An International Search Report or Declaration under PCT Article 17(2)(a):
  - ☐ has been transmitted by the International Bureau. Date of mailing (from form PCT/IB/308): \_\_\_\_\_ A copy of form PCT/IB/308 is enclosed
  - ☐ is not required as the application was searched by the United States International Searching Authority.
  - ☒ A copy of the International Search Report is transmitted herewith - date of mailing 05/04/2000.

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d. ( ) has been submitted by applicant on (date) \_\_\_\_\_.

2. A Statement of prior art under 37 CFR 1.97 and 1.98:

a. ( ) is transmitted herewith including copies of the references cited on the attached form PTO-1449.

b. ( ) will be transmitted within THREE MONTHS of the date of submission of requirements under 35 U.S.C. 371(c).

c. ( ) was previously submitted by applicant on \_\_\_\_\_, in application serial no. \_\_\_\_\_.

3. ( ) An executed Assignment is transmitted herewith for recording.  
A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.

a. ( ) **Please charge the \$40.00 assignment recordation fee to Deposit Account No. 23-1703.**

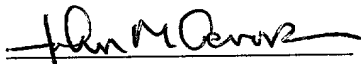
b. ( ) Enclosed is a check in the amount of \$\_\_\_\_\_.

4. **Other document(s) or information included:**

- Copy of PCT/RO/101 - The PCT Request Form;
- Three (3) sheets of drawings; and
- Return postcard.

Respectfully submitted,

22 May 2001  
DATE

  
John M. Genova  
Reg. No. 32,224  
Applicants' Attorney  
Attorney's Direct Line (212)-819-8832

Customer No. 007470  
(212 ) 819-8200

Enclosures

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Thomas Heering  
Serial No. : 09/856,537  
Filed : May 22, 2001  
For : METHOD FOR BILLING SERVICES WHICH  
CAN BE RETRIEVED FROM THE INTERNET  
Examiner : To be assigned  
Group Art Unit : To be assigned

I hereby certify that this paper is being  
deposited with the United States Postal Service  
as first class mail in an envelope addressed to:  
Assistant Commissioner for Patents  
Washington, D.C. 20231.

Andrew Fessak P48,528  
Agent Name PTO Reg. No.

Andrew Fessak 8/8/01  
Signature Date of Signature

Box PCT  
Assistant Commissioner for Patents  
Washington, D.C. 20231

**PRELIMINARY AMENDMENT**

Sir:

Preliminary to examination on the merits, please amend the referenced application as follows:

**IN THE CLAIMS:**

**Cancel claims 2, 4 and 5. Amend claims 1, 3, and 6-10 as follows:**

1. (Amended) A method of billing a fee for a service via an electronic route, comprising the steps of:

- a) transmitting a telephone number of a chargeable service telecommunication connection associated with a service provider to a service buyer;
- b) monitoring the build-up of the telecommunication connection between the provider and the buyer by a line provider;
- c) billing the fee for the requested service via the service connection; and
- d) releasing the requested service to the buyer by the service provider,

whereby an order code is allocated and transmitted to the service buyer during transmission of the telephone service number by the service provider, and wherein the service connection is a direct-dial connection of which the final number is used as the order code.

3. (Amended) The method as claimed in claim 1, wherein the requested service is billed after the order code has been confirmed by the service buyer.

6. (Amended) The method as claimed in claim 1, wherein the service line is interrupted by the service provider following the complete billing of the fee for the requested service.

7. (Amended) The method as claimed in claim 1, wherein billing is terminated if the service line is interrupted before complete billing of the fee for the requested service.

8. (Amended) The method as claimed in claim 1, wherein billing is carried out continuously in parallel with transmission of the service.

9. (Amended) The method as claimed in claim 1, wherein the line to the service connection is built up automatically on the side of the buyer.

10. (Amended) The method as claimed in claim 1, wherein the requested service is built up via the Internet.



## REMARKS

The subject application is the U.S. national phase of International Application PCT/DE99/03771 ("the PCT application").

The original claims of the subject application have been amended to place the claims in conformance with U.S. patent practice, and to reflect amendments made in the PCT application. Specifically, the claims have been amended to remove the dependency of a multiple dependent claim on another multiple dependent claim. Claim 1 has been amended to incorporate the embodiments of claims 2, 4, and 5, now canceled. Claims 2, 4, and 5 have canceled.

Applicant submits that no new matter is introduced by the amendments to the claims.

# **Claims 1-7- Version with Markings to Show Changes Made**

1. A method of **[for]** billing a fee for a service **[s, in particular services which can be**  
**retrieved from the Internet]** via an electronic route, comprising the **[following]** steps of:
  - a) transmitting a **[Transmission of the]** telephone number of a chargeable service  
telecommunication connection associated with a **[(premium rate connection) from the]**  
service provider to a **[the]** service buyer;
  - b) monitoring **[Monitoring]** the build-up of the telecommunication connection between  
the provider and the buyer **[line to the transmitted service connection]** by a **[the]** line  
provider;
  - c) billing **[Billing of]** the fee for the requested service via the service connection; and
  - d) releasing **[Release of]** the requested service to the buyer by the service provider,  
whereby an order code is allocated and transmitted to the service buyer during  
transmission of the telephone service number by the service provider, and wherein the  
service connection is a direct-dial connection of which the final number is used as the  
order code.
3. The method as claimed in claim 1, wherein **[2, characterized in that, after the service line**  
**has been built up,]** the requested service is billed **[only]** after the **[allocated]** order code  
has been confirmed by the service buyer.

6. The method as claimed in claim 1, wherein [one of claims 1 to 5, characterized in that] the service line is interrupted by the service provider following the complete billing of the fee for the requested service.
7. The method as claimed in claim 1, wherein [one of claims 1 to 6, characterized in that no] billing is terminated [carried out] if the service line is interrupted before [the] complete billing of the fee for the requested service.
8. The method as claimed in claim 1, wherein [one of claims 1 to 6, characterized in that the] billing is carried out continuously in parallel with transmission [the provision] of the service.
9. The method as claimed in claim 1, wherein [one of claims 1 to 8, characterized in that] the line to the service connection is built up automatically on the side of the buyer.
10. The method as claimed in claim 1, wherein [one of claims 1 to 9, characterized in that the connection to] the requested service [connection] is built up via the Internet.

CONCLUSION

Upon entry of this Preliminary Amendment, claims 1, 3, and 6-10 are pending. Applicant respectfully submits that claims 1, 3, and 6-10 are directed to patentable subject matter.

Accordingly, Applicant requests allowance of the claims.

No fee should be due in connection with this Communication. However, if a fee is required, the Assistant Commissioner is authorized to charge the fee to Deposit Account No. 23-1703.

Dated: Aug 8, 2001

Respectfully submitted,

Andrew Fessak

Andrew Fessak  
Reg. No. P48,528  
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METHOD FOR BILLING SERVICES WHICH CAN BE RETRIEVED FROM THE  
INTERNET

5 The invention relates to a method for billing services,  
in particular services which can be retrieved from the  
Internet via an electronic route.

10 With the expansion of electronic media, the marketing  
of goods and services via this route has also increased  
considerably. In recent times, it has become common for  
products to be presented on television in special  
commercial transmissions, which products then can be  
ordered by telephone. On the Internet, as well, there  
is to an increasing extent the possibility of directly  
15 ordering goods or services which are offered. Provided  
the goods are supplied by conventional routes, that is  
to say for example by post or forwarding agent, the  
services provided are mostly recorded on the  
traditional bill, for example by means of cash on  
20 delivery or against invoice. However, the disadvantage  
of this system is considerable secondary costs as a  
result of the necessary reminders and as a result of  
cancellations, in a not inconsiderable number. The  
outlay on administration bears no relationship to the  
25 value of the goods, particularly in the case of low-  
price offers.

Also widespread is billing the services provided or to  
be provided via credit cards or using the debit method.  
30 However, estimates assume that the services provided  
cannot be billed in approximately 40% of the cases as a  
result of credit-card misuse or withdrawn debits. This  
has a particularly serious effect on the provider who  
provides services in advance or whose service, once  
35 provided, cannot be reclaimed. The losses to be  
expected as a result of misuse have to be included in  
the calculation of the required prices, which makes the  
offers unattractive to the cost of the genuine  
purchaser.

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In addition to the classical offering of goods, the Internet also offers the possibility of downloading files. For example, information files, image files or programs can be downloaded. Billing such services is likewise a problem. The buyer is interested in immediate delivery, which is technically possible. The service would lose considerably in attractiveness if it were to be provided only after the processing of the payment via the conventional route. However, on the side of the interested person, there is often a certain reluctance to disclose the number of his credit card in order that the requested amount can be debited. For the provider, on the other hand, there are the risks of misuse described above. In addition, high secondary costs arise in credit-card transactions, and in the case of low amounts do not bear any relationship to the value of the service provided.

The present invention is based on the object of providing a billing method for services which ensures the immediate billing of a service to be provided.

According to the invention, the object is achieved by a method for billing services having the features of patent claim 1.

The method of the invention is used in particular for billing services which can be retrieved from the Internet via an electronic route. It comprises, firstly, the transmission of the telephone number of a chargeable service telecommunication connection (so-called premium-rate connection) from the service provider to the service buyer. Chargeable service connections have recently become available from all telecommunications companies. For dialing such a service connection, the person dialing is charged with a specific amount per unit time, and this is billed in the next telephone invoice. The owner of the connection

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receives a specific proportion of the amount invoiced. For example, in Germany at present so-called "0190 numbers" are in operation, for which the person dialing is invoiced with an amount between DM 0.80 and DM 3.60 per minute, of which the telephone company receives about DM 0.60. The remaining amount is credited to the owner of the connection. As the next method step, the service provider monitors to see whether a line has been built up to the service connection indicated. If this is so, the amount required for the service requested is charged via the chargeable service connection and the requested service is then released.

For example, a computer program which is to be downloaded from the Internet can be billed in this way. The interested person, during his search on the internet, encounters the offer from a provider to download a computer program. After the request for the program, a service telephone number is given to the caller by the provider, for example by inserting it on the appropriate Internet web page. The customer dials the appropriate service telephone number. The completion of this connection is monitored by the service provider, for example via an electronic route. As soon as the connection has been made, the billing for the service requested begins via the charges for the service connection. After the billing has been completed, the service requested is provided. The file can be downloaded.

A further development of the method of the invention provides for a specific order code to be transmitted simultaneously with the transmission of the service telephone number by the service provider. The code can have many characters. A code can be allocated once or else repeatedly, if it is ensured that the amounts invoiced can be ascribed to the associated order. The customer then calls the service telephone number and

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service telephone numbers in the telephone invoice, the amounts invoiced can be understood accurately.

A preferred exemplary embodiment of the invention will be explained in more detail below using the appended figures:

Figures 1 - 7 show the step-by-step sequence of the method of the invention, using the example of a file to be downloaded from the Internet.

In step 1, the service buyer uses his computer (PC) to make contact with the Internet server (S). On the Internet, a service provider is represented by his web site (A).

In step 2, the service buyer makes contact, via the Internet server (S), with the provider via the web site (A) of the latter. There, he finds various service offers, for example a file which he would like to download. The individual service offers are provided with corresponding price information. The service buyer selects the file he wants by clicking on the corresponding symbol.

Then, according to method step 3, a connection is produced from the service provider (A), via the Internet server (S), to a monitoring device (B). In this case, the amount required for the requested service, and also the telephone number of a chargeable service telephone connection (T2) associated with the service provider (A), is transmitted. The telephone number of the service telephone connection (T2) is also indicated on the Internet web site of the provider so that it can be seen by the buyer. The buyer is requested to dial the service connection.

In step 4 of the method, the monitoring device (B) makes contact with the service telephone connection

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The method according to the invention can be processed automatically on the side of the buyer. A computer is able to detect the telephone number of the service connection which is transmitted and to dial it automatically. This can preferably be done via the Internet. The separation of the data paths of the service connection and of the actual Internet data line is carried out on the internet.

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Patent claims

1. A method for billing services, in particular services which can be retrieved from the Internet via an electronic route, comprising the following steps:

a) Transmission of the telephone number of a chargeable service telecommunication connection (premium rate connection) from the service provider to the service buyer;

b) Monitoring the build-up of the line to the transmitted service connection by the line provider;

c) Billing of the requested service via the service connection;

d) Release of the requested service by the service provider.

2. The method as claimed in claim 1, characterized in that, with the transmission of the telephone service number by the service provider, an order code is allocated and transmitted to the service buyer.

3. The method as claimed in claim 2, characterized in that, after the service line has been built up, the requested service is billed only after the allocated order code has been confirmed by the service buyer.

4. The method as claimed in one of claims 1 to 3, characterized in that, the service connection used is a direct-dial connection.

5. The method as claimed in one of claims 2 to 4, characterized in that the direct-dial number of the service connection is used as an order code.

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6. The method as claimed in one of claims 1 to 5, characterized in that the service line is interrupted by the service provider following the complete billing of the requested service.

5

7. The method as claimed in one of claims 1 to 6, characterized in that no billing is carried out if the service line is interrupted before the complete billing of the requested service.

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8. The method as claimed in one of claims 1 - 6, characterized in that the billing is carried out continuously in parallel with the provision of the service.

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9. The method as claimed in one of claims 1 to 8, characterized in that the line to the service connection is built up automatically on the side of the buyer.

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10. The method as claimed in one of claims 1 to 9, characterized in that the service connection is built up via the Internet.

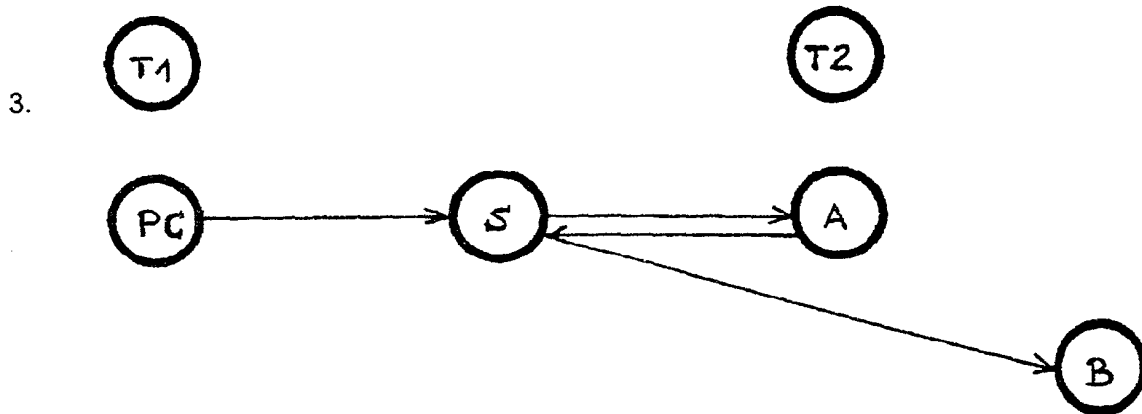
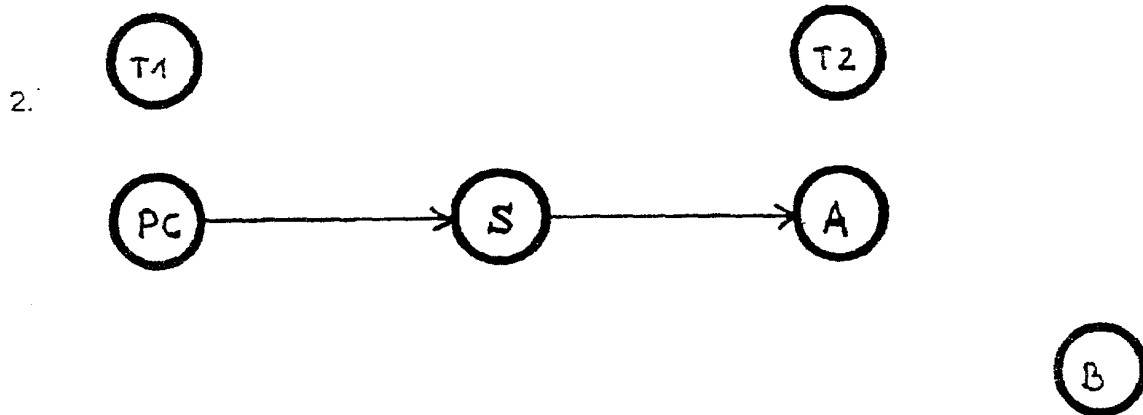
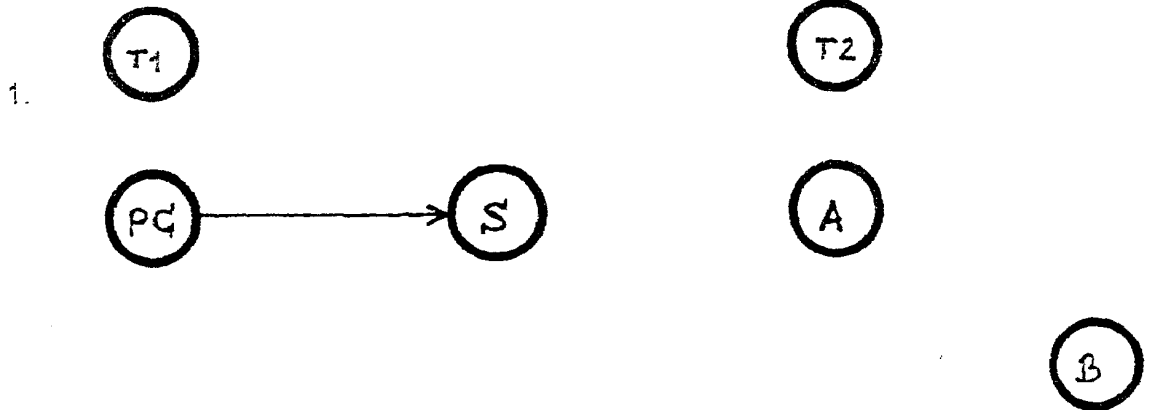
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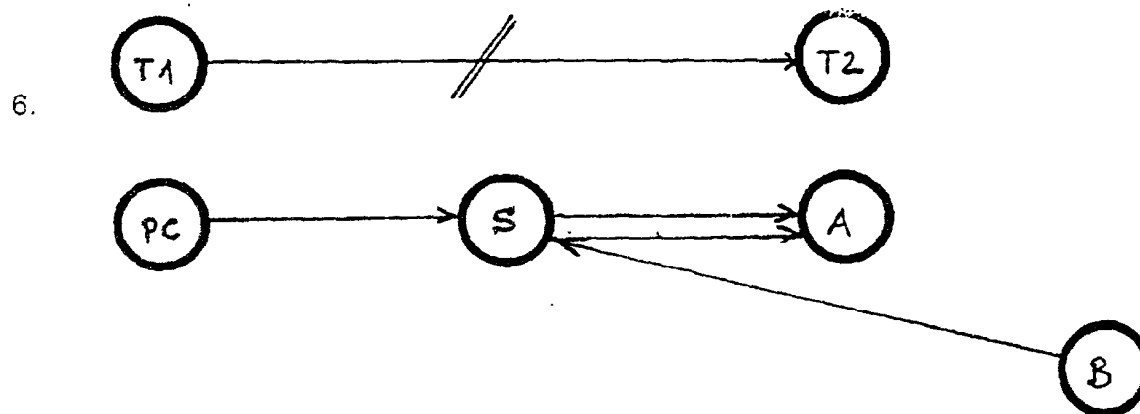
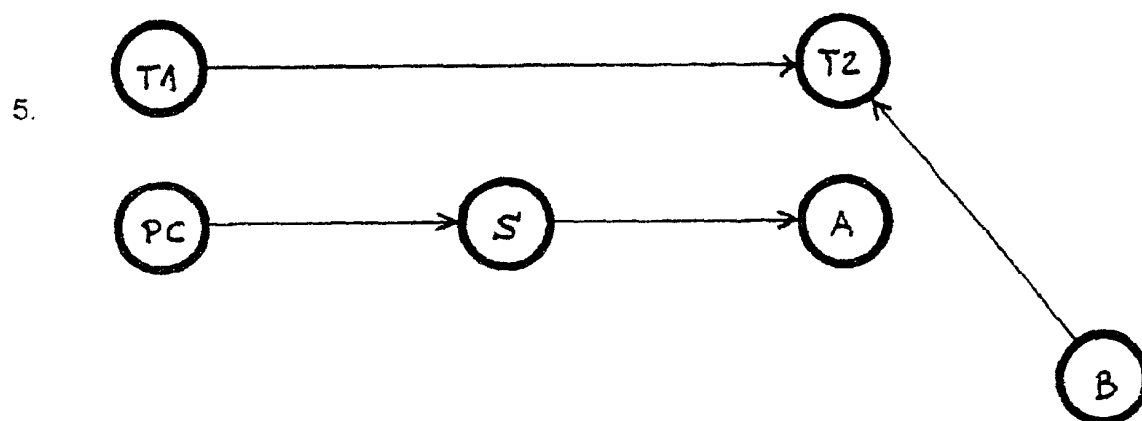
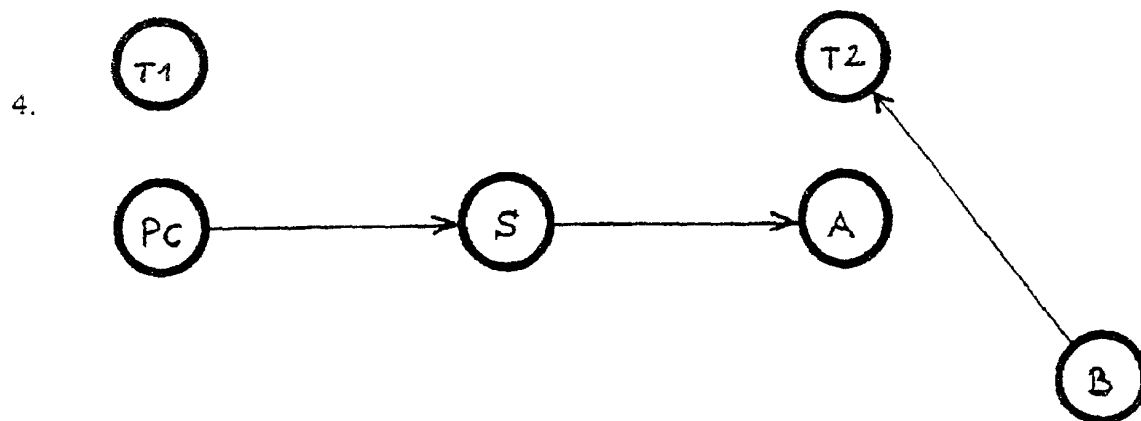
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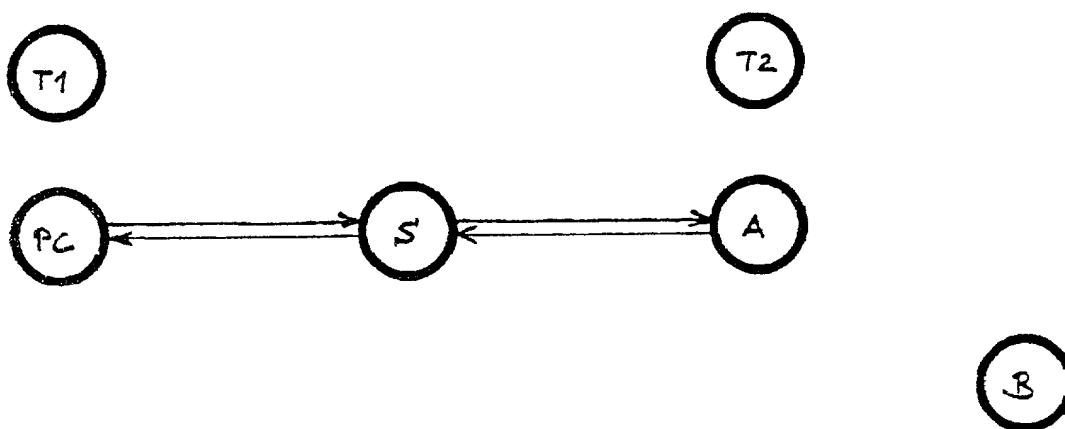
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7.



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Docket Number: 6168705-0006

**DECLARATION FOR PATENT APPLICATION**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

**METHOD FOR BILLING SERVICES WHICH  
CAN BE RETRIEVED FROM THE INTERNET**

the specification of which is attached hereto unless the following box is checked:

☒ was filed on 29 NOVEMBER 1999 as United States Application Number \_\_\_\_\_  
or International Application Number PCT/DE99/03771 and was amended on 15 January 2001  
(if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR § 1.56.

I hereby claim foreign priority benefits under 35 U.S.C. § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT international application which designated at least one country other than the United States, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)

Priority Not Claimed

<u>198 54 860.5</u>	<u>DE</u>	<u>27 November 1998</u>	<u>          </u>
Number	Country	Day/Month/Year Filed	

<u>          </u>	<u>          </u>	<u>          </u>	<u>          </u>
Number	Country	Day/Month/Year Filed	

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I hereby claim the benefit under 35 U.S.C. § 119(e) of any United States provisional application(s) listed below

(Application Number)

(Filing Date)

I hereby claim the benefit under 35 U.S.C. § 120 of any United States application(s), or § 365(c) of any PCT international application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT international application in the manner provided by the first paragraph of 35 U.S.C. § 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application

(Application Number)

(Filing Date)

(Status--patented, pending, abandoned)

(Application Number)

(Filing Date)

(Status--patented, pending, abandoned)

I/we hereby appoint **Practitioners at Customer Number 007470** as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith.

Address all correspondence to Customer No. 007470

Telephone No.: 212-819-8200; Facsimile No.: 212-354-8113

Direct telephone calls to: John M. Genova, Esq. Direct Telephone: 212-819-8832.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believe to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole or first inventor (first name, middle initial, last name): Thomas Heering

Sole or first inventor's signature *Th. Heering* Date: \_\_\_\_\_

Residence: Dresden, Germany Citizenship: German

Post Office Address: Wittenberger Strasse 90  
D-01277 Dresden, Germany

\_\_\_\_ Additional inventors are named on the page attached hereto.